

Exhibit A

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

ENTROPIC COMMUNICATIONS, LLC,) (
PLAINTIFF,) (CIVIL ACTION NO.
) (2:22-CV-125-JRG-RSP
VS.) (MARSHALL, TEXAS
) (
CHARTER COMMUNICATIONS, INC.,) (
Et Al.,) (DECEMBER 8, 2023
DEFENDANT.) (9:34 A.M.

PRETRIAL HEARING

BEFORE THE HONORABLE ROY S. PAYNE
UNITED STATES MAGISTRATE JUDGE

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(Proceedings recorded by mechanical stenography, transcript
produced on a CAT system.)

09:25:18
09:25:18

09:25:18 1 COURT SECURITY OFFICER: All rise.

09:25:19 2 THE COURT: Good morning. Please be seated.

09:34:57 3 For the record, we're here for the completion of
09:35:04 4 the final pretrial conference in Entropic Communications
09:35:10 5 versus Charter Communications, which is Case No. 2:22-125
09:35:14 6 on our docket.

09:35:15 7 Would counsel state their appearances for the
09:35:18 8 record?

09:35:18 9 MR. WARD: Good morning, Your Honor. Johnny Ward,
09:35:24 10 along with Alan Littmann, Jim Shimota, Jenny Hartjes,
09:35:30 11 Shaun Zhang, Connor Meggs, Katie Allor, and Courtney
09:35:37 12 Neufeld. I didn't mess that up.

09:35:37 13 THE COURT: Thank you, Mr. Ward.

09:35:37 14 MR. WARD: I think I got it. All right.

09:35:37 15 THE COURT: Thank you. You've obviously had your
09:35:39 16 coffee already this morning.

09:35:39 17 MR. WARD: Well, I mean, I had one job. They said
09:35:42 18 if you mess it up, you won't get to speak again. Despite
09:35:43 19 my efforts to mess it up, I apparently got it right.

09:35:46 20 THE COURT: Well, congratulations.

09:35:48 21 Good morning, Mr. Dacus.

09:35:49 22 MR. DACUS: Good morning, Your Honor. Deron
09:35:51 23 Dacus, here with Betsy Long and Dan Reisner on behalf of
09:35:55 24 Charter, Your Honor, and we're ready to proceed.

09:35:57 25 THE COURT: All right. Thank you, Mr. Dacus.

09:35:59 1 We've got a number of matters on the agenda today,
09:36:05 2 and a couple of them relate to motions filed since the last
09:36:10 3 time we gathered. Why don't we go ahead and address those
09:36:16 4 first. We can start with Charter's motion for protective
09:36:24 5 order, and let me hear first from -- actually, let me hear
09:36:29 6 from Plaintiff on that motion first.

09:36:43 7 Good morning, Mr. Littmann.

09:36:47 8 MR. LITTMANN: Good morning, Your Honor.

09:36:50 9 Your Honor, as the briefing noted, this relates to
09:36:54 10 the order that you issued with respect to Dr. Almeroth's
09:37:00 11 opinion. Entropic had moved to strike two paragraphs in
09:37:04 12 Dr. Almeroth's supplemental opinion, and those were
09:37:09 13 relating to newly produced evidence regarding Mr. Stafford
09:37:15 14 and what Mr. Stafford told Dr. Almeroth, as well as some
09:37:20 15 exhibits that were produced for the first time, along with
09:37:22 16 his report.

09:37:23 17 We had moved to strike those. Your Honor denied
09:37:25 18 our motion to strike, but ordered that they produce two
09:37:31 19 witnesses for one hour each. One was Mr. Stafford to
09:37:36 20 discuss what he had told Dr. Almeroth, and the other was a
09:37:39 21 corporate representative to discuss the exhibit that was
09:37:43 22 produced with Dr. Almeroth's report.

09:37:44 23 Your Honor noted that it would be prejudicial to
09:37:49 24 present the evidence to the jury without allowing
09:37:51 25 discovery.

09:37:51 1 THE COURT: So why doesn't their withdrawal of
09:37:54 2 those paragraphs moot the need for the deposition?

09:37:58 3 MR. LITTMANN: So we asked for clarification about
09:38:01 4 what that withdrawal actually entailed, and I think herein
09:38:05 5 lies the rub is that we don't actually believe what they're
09:38:08 6 really doing is withdrawing any reliance on those
09:38:11 7 paragraphs because what they're -- what they really want to
09:38:13 8 do, we believe, is to still bring Mr. Stafford to testify
09:38:18 9 about exactly what he was -- what's disclosed in
09:38:21 10 Dr. Almeroth's report. He wasn't -- Mr. Stafford hasn't
09:38:25 11 been deposed since then.

09:38:27 12 And then they want their experts, and they
09:38:29 13 expressly said that, that they reserve the right to have
09:38:32 14 any witness discuss the substance of those paragraphs,
09:38:34 15 including experts, to the extent otherwise disclosed in
09:38:37 16 their report.

09:38:37 17 So we don't know what else those -- that's a
09:38:42 18 direct quote. And so we don't know what else they are
09:38:44 19 going to be relying on if Mr. Stafford comes in here and
09:38:48 20 presents that evidence. And that's the exact evidence, as
09:38:52 21 Your Honor noted, would be prejudicial without giving us an
09:38:54 22 opportunity to conduct discovery on it.

09:38:57 23 Furthermore, the screenshots, that DX-24
09:39:05 24 screenshot was something that only came in, and the only
09:39:08 25 witness that it was disclosed through is Dr. Almeroth. And

09:39:11 1 they've refused to exclude that as well. And so in that
09:39:16 2 situation, nobody else has indicated they can testify on it
09:39:16 3 or that they would be introducing that evidence through
09:39:19 4 anyone else.

09:39:19 5 And so by refusing to exclude that, I think what
09:39:23 6 it does is it gives us a pretty good indication that
09:39:26 7 actually they're not really withdrawing those paragraphs at
09:39:28 8 all. What they're doing is they're trying to circumvent
09:39:31 9 this Court's order and just trying to get it in through
09:39:34 10 other means without giving us the opportunity to conduct
09:39:37 11 discovery on that.

09:39:37 12 And, obviously, as we come up to trial, I think
09:39:39 13 what -- you know, it's always dangerous in front of a jury
09:39:42 14 to be asking questions that we don't know the answers to.
09:39:45 15 And I think that's exactly what they're trying to do right
09:39:50 16 now is trying to say, you know, take your chances, but
09:39:51 17 we're not going to give you the discovery on the very
09:39:53 18 things that the Court ordered discovery to be provided on.

09:39:56 19 THE COURT: To the extent that your concern deals
09:40:00 20 with what Dr. Almeroth might say, I think that's something
09:40:04 21 that I can address with the defense counsel in a moment.

09:40:09 22 But as long as Dr. Almeroth is not going to
09:40:17 23 express opinions related to those two paragraphs, how are
09:40:21 24 you not in the same position you would have been if we had
09:40:24 25 simply granted your motion to strike?

09:40:27 1 MR. LITTMANN: Well, I think -- I think that
09:40:30 2 primarily revolves around the DX-24, that exhibit, because
09:40:36 3 if -- if Your Honor wants to revisit and grant the motion
09:40:39 4 to strike, I think that is one way of resolving it.
09:40:44 5 However, I still think that the DX-24 needs to be excluded
09:40:47 6 because our understanding was that came in solely through
09:40:49 7 Dr. Almeroth and those -- and those paragraphs. And so we
09:40:55 8 understand that had that been granted, there was nobody
09:40:58 9 else to actually lay a foundation for that exhibit. There
09:41:01 10 was nobody else that would have been able to testify about
09:41:03 11 it at all. It wasn't related back to what Mr. Stafford
09:41:07 12 said.

09:41:07 13 And in that situation, Mr. Bakewell, their damages
09:41:09 14 expert, also doesn't rely on it. He relies on other
09:41:13 15 conversations he had with Mr. Stafford, but he doesn't rely
09:41:17 16 on that exhibit.

09:41:18 17 So I think that's where -- that's where there
09:41:20 18 would still be a difference, and there would still be
09:41:23 19 something up for discussion.

09:41:24 20 And -- and I understand that certainly had
09:41:27 21 Your Honor granted that motion and been excluded or if --
09:41:31 22 you know, if it is, you know, hard and fast that they don't
09:41:33 23 simply get to introduce all of this information by other
09:41:37 24 means, at least through Dr. Almeroth through other means, I
09:41:41 25 think we're going to have a situation where we're in front

09:41:43 1 of a jury, Mr. Stafford is going to come in, he's going to
09:41:47 2 testify to this. Dr. Almeroth is likely going to be
09:41:49 3 sitting there listening. And whether the jury is going to
09:41:52 4 be able to understand what Dr. Almeroth is relying on and
09:41:55 5 whether he's going to be able to sort of put on blinders
09:41:58 6 and say, well, no, I'm not really -- I'm not really relying
09:42:00 7 on the things I just heard Mr. Stafford say, and he sort of
09:42:04 8 unlearned those things that he heard before or have the
09:42:07 9 jury conclude somehow that, you know, Dr. Almeroth isn't
09:42:10 10 actually listening to that portion but he's -- and not
09:42:13 11 really resting his opinion on that portion but on something
09:42:16 12 else, I think that's going to create quite a bit of
09:42:19 13 confusion at the trial.

09:42:20 14 And I think the easiest way to resolve that would
09:42:22 15 be to go with what your order originally said, which is
09:42:25 16 simply let's just conduct the depositions. They're short.
09:42:28 17 We can still get them done. We're prepared to do it
09:42:31 18 tomorrow. And I think it avoids the surprise and the
09:42:36 19 complications of having everybody wonder kind of what
09:42:40 20 exactly is Dr. Almeroth relying on when he's sitting in the
09:42:45 21 court listening to these statements.

09:42:47 22 THE COURT: All right. Thank you, Mr. Littmann.

09:42:54 23 MR. LITTMANN: Thank you.

09:42:56 24 MR. REISNER: Your Honor, the -- the exhibit,
09:43:00 25 DTX-24, that Entropic is concerned about was already

09:43:03 1 pre-admitted, so I don't understand why we're here debating
09:43:07 2 that today.

09:43:07 3 Ms. -- Dr. Almeroth's not going to testify about
09:43:13 4 DTX-24. That doesn't mean that Mr. Stafford can't testify
09:43:18 5 about that. This -- this was disclosed in the September
09:43:22 6 7th interrogatory response, this -- these screenshots
09:43:27 7 showing them -- showing the [REDACTED]. If they
09:43:30 8 thought that they were entitled and needed a deposition of
09:43:34 9 Mr. Stafford, they should have raised it then, not on the
09:43:38 10 eve of trial.

09:43:39 11 It's going to be -- it would be highly prejudicial
09:43:42 12 to us to have to prepare and offer Mr. Stafford to testify
09:43:47 13 on Sunday, the day before trial begins while we have a lot
09:43:50 14 of other things that we have to do for something that they
09:43:56 15 have no excuse for not raising back in September or
09:44:02 16 earlier. We disclosed the [REDACTED] in an earlier
09:44:06 17 interrogatory response on August 10th.

09:44:09 18 THE COURT: Well, talk to me, Mr. Reisner, about
09:44:17 19 why shouldn't I, then, just take the path of simply
09:44:20 20 granting the motion to strike as to those two paragraphs
09:44:24 21 and there being, therefore, no ambiguity about
09:44:31 22 Dr. Almeroth's ability to testify about that.

09:44:35 23 MR. REISNER: Yeah, we -- Your Honor, we -- we
09:44:36 24 think you should -- you should do that. The only thing I
09:44:39 25 want to clarify, okay, is that Dr. Almeroth, in his earlier

09:44:46 1 expert report, already offered an opinion acknowledging
09:44:52 2 that [REDACTED]. He -- he didn't offer an opinion
09:44:55 3 on this exhibit. He's not going to testify that he thinks
09:44:58 4 this exhibit shows it was shut down or that he even thinks
09:45:02 5 it was shut down.

09:45:03 6 But -- but he does -- he should be able to offer
09:45:07 7 an opinion that you can't have infringement of method
09:45:10 8 claims if you're not practicing them. And that opinion was
09:45:13 9 disclosed previously. He won't -- he won't testify as to
09:45:20 10 anything that's in these paragraphs that are stricken that
09:45:22 11 wasn't disclosed earlier.

09:45:26 12 THE COURT: All right. Thank you, Mr. Reisner.

09:45:34 13 Mr. Littmann, I'll give you the last word on that.

09:45:37 14 MR. LITTMANN: Thank you, Your Honor. I'll make
09:45:38 15 it quick.

09:45:39 16 Just to clarify, Your Honor, what Dr. Almeroth
09:45:47 17 testified to before is that the project was -- or what he
09:45:52 18 wrote in his report was that the project was stalled. He
09:45:55 19 didn't describe any basis for why it was allegedly shut
09:45:59 20 down. And that's what Mr. Stafford's testimony and that's
09:46:02 21 what the exhibit elaborate upon. And so it's not the same
09:46:09 22 as what he had disclosed before at all.

09:46:11 23 I'm looking at Paragraph 183 of his report. He
09:46:14 24 says: Right now the project is stalled, and it did not get
09:46:18 25 the go-ahead -- he's quoting the Charter witness -- from

09:46:21 1 our executive management to deploy on a larger scale. So
09:46:24 2 he doesn't describe the mechanism or the basis on which
09:46:26 3 they claim they shut it down.

09:46:28 4 And so we still think that what -- what we need
09:46:32 5 here is a deposition to understand what exactly it is that
09:46:37 6 happened. Their -- their witnesses are clearly going to
09:46:40 7 rely on it. We don't know how Mr. Stafford could possibly
09:46:42 8 come in and testify to the late-produced exhibit that --
09:46:48 9 that was produced when Dr. Almeroth actually issued his
09:46:53 10 report when that was not produced through -- or we were not
09:46:56 11 given an opportunity to depose Mr. Stafford on it. It was
09:47:00 12 given to us through Dr. Almeroth.

09:47:02 13 THE COURT: Do you dispute that that exhibit has
09:47:04 14 been pre-admitted?

09:47:05 15 MR. LITTMANN: We did not object to that. We did
09:47:08 16 not object to that exhibit. So, yes, I agree that we did
09:47:11 17 not object to that exhibit, however, we did not object to
09:47:13 18 it because we believed that it rose and fell with
09:47:17 19 Dr. Almeroth -- Almeroth's opinions on those particular
09:47:20 20 paragraphs which we moved to strike.

09:47:22 21 And so because he was the only witness that was --
09:47:27 22 that was there that had offered that evidence, that was --
09:47:31 23 that was our understanding.

09:47:32 24 So if -- if we're being told now that what
09:47:36 25 Mr. Stafford is going to do is he's going to testify about

09:47:38 1 that exhibit, then frankly we can cut this short, limit it
09:47:43 2 to one deposition, and just have Mr. Stafford testify about
09:47:44 3 that exhibit. And that would be -- that would make it
09:47:48 4 easier for everybody.

09:47:49 5 THE COURT: Well, to the extent, Mr. Littmann,
09:47:51 6 that you made these decisions based on strategic moves, I
09:48:00 7 think it's too late now to walk those back.

09:48:03 8 I'm going to amend the order on Dr. Almeroth's
09:48:13 9 opinions -- in other words, the order on your motion to
09:48:17 10 strike -- to grant it as to those two additional
09:48:23 11 paragraphs. I do find that that moots the Court's order
09:48:29 12 regarding the additional depositions. And whether or not
09:48:38 13 Mr. Stafford's testimony about that document is appropriate
09:48:47 14 as fact testimony is something that you can object to
09:48:50 15 contemporaneously if you think he's exceeded the scope of
09:48:54 16 what a fact witness can provide.

09:48:56 17 MR. LITTMANN: Thank you, Your Honor. Understood.

09:48:58 18 THE COURT: All right. So the Defendant's motion
09:49:05 19 for protective order is granted to that extent.

09:49:08 20 That takes us to the Plaintiff's motion to
09:49:14 21 dismiss, and I'd like to hear from the Plaintiff first on
09:49:21 22 that.

09:49:21 23 MR. ZHANG: Good morning, Your Honor. This is
09:49:28 24 Shaun Zhang on behalf of Entropic.

09:49:29 25 THE COURT: Good morning.

09:49:29 1 MR. ZHANG: In accordance with the Court's order
09:49:32 2 and the practice of this -- of this Court, we informed
09:49:36 3 Charter that we are not proceeding to trial on three of the
09:49:40 4 six asserted patents. In response to that, Charter
09:49:43 5 requested that we dismiss those claims on those patents
09:49:46 6 with prejudice.

09:49:46 7 And we informed them, based on the precedent of
09:49:49 8 this Court, that the effect of withdrawing claims and
09:49:52 9 narrowing the issues before trial was a dismissal without
09:49:55 10 prejudice, and that's really the dispute before the Court.
09:49:58 11 It wouldn't be a dispute if Charter didn't insist that the
09:50:03 12 dismissal would be with prejudice. Our motion memorializes
09:50:05 13 the effect -- and it's the norm in this Court that when
09:50:08 14 issues are narrowed and claims are withdrawn, that that is
09:50:10 15 done without prejudice.

09:50:11 16 THE COURT: Do you intend to or does Entropic
09:50:14 17 intend to reassert these three patents against Charter in
09:50:20 18 some other proceeding?

09:50:21 19 MR. ZHANG: Your Honor, I -- I can't speak to that
09:50:24 20 specific question. The motion really is only filed because
09:50:29 21 this issue was raised by Charter. This exact issue
09:50:34 22 was actually -- typically this issue doesn't get brought
09:50:37 23 up, so we don't have a lot of precedent on this, but this
09:50:38 24 exact issue was addressed in the Constellation case,
09:50:41 25 Constellation versus LG before Judge Gilstrap earlier this

09:50:44 1 year.

09:50:45 2 There, the Defendant also contested that the
09:50:47 3 dismissal should be with prejudice with -- of claims that
09:50:50 4 were withdrawn and narrowed before trial, same as that
09:50:54 5 issue went before Judge Gilstrap, and Judge Gilstrap
09:50:56 6 granted the motion without prejudice. And I have copies of
09:51:00 7 that -- of that order, if that would be helpful, Your
09:51:02 8 Honor.

09:51:02 9 THE COURT: You know, I'm -- I am familiar with
09:51:04 10 that issue. It has a lot to do with the stage of the
09:51:08 11 proceedings and the purpose of the narrowing. If it is
09:51:18 12 simply involving claims of a patent, we never have an issue
09:51:24 13 with that. If it's the patent itself, that's a little
09:51:27 14 broader.

09:51:30 15 But the Defendant has a legitimate concern if the
09:51:34 16 Plaintiff is withdrawing those with the intent to reurge
09:51:38 17 them elsewhere. And it's concerning to me if you're not in
09:51:44 18 a position to comment on that.

09:51:47 19 MR. ZHANG: Your Honor, might I confer with
09:51:51 20 co-counsel on this?

09:51:52 21 THE COURT: Yes.

09:52:28 22 MR. ZHANG: Thank you, Your Honor.

09:52:29 23 After conferring with co-counsel, we can confirm
09:52:32 24 that these patents that were withdrawn as part of this
09:52:36 25 litigation, those three patents we don't intend to assert

09:52:40 1 again against Charter. There are family members in one of
09:52:41 2 those patents that we reserve the right to assert against
09:52:43 3 Charter and other Defendants.

09:52:45 4 THE COURT: Well, the way I would likely resolve
09:52:46 5 this, then, is to grant your request to dismiss without
09:52:53 6 prejudice, but to condition it upon the payment by Entropic
09:52:59 7 to Charter of Charter's fees in the event that you do
09:53:06 8 reurge these same patents against Charter in another forum.

09:53:11 9 I think -- I've always felt that addresses the
09:53:16 10 primary concern that the Defendants have in terms of being
09:53:20 11 put to the expense of recreating their defense in the event
09:53:27 12 they're reurged.

09:53:29 13 But let me hear from the Defendants on that point.
09:53:33 14 Thank you --

09:53:33 15 MR. ZHANG: Thank you.

09:53:34 16 THE COURT: -- Mr. Zhang.

09:53:37 17 MR. REISNER: As Your Honor has already
09:53:43 18 recognized, that's -- you know, our concern is that
09:53:47 19 January, some time next year, sometime in the near future,
09:53:51 20 if these patents are dropped without prejudice, Entropic
09:53:54 21 will turn around and file a new lawsuit, we'll have new
09:53:59 22 discovery, new theories, and we'll be litigating the same
09:54:01 23 issues and new issues and a new trial at great expense and
09:54:05 24 inconvenience to our witnesses and disruption of our
09:54:10 25 business.

09:54:11 1 And the Fifth Circuit cases that we cited all
09:54:13 2 discuss how dismissing without prejudice on the eve of
09:54:17 3 trial, you know, is prejudicial.

09:54:19 4 THE COURT: Well, Rule 41 specifically grants the
09:54:25 5 District Court the discretion to impose conditions, and the
09:54:32 6 condition that makes sense here would be the condition
09:54:34 7 regarding payment of fees in the event that they are
09:54:38 8 reurged. Obviously, that is intended also to be a
09:54:45 9 disincentive to the Plaintiff to reurge those same patents
09:54:51 10 in another forum.

09:54:53 11 If you have any argument as to why that wouldn't
09:54:56 12 be a sufficient protection for Charter's interest in this
09:55:02 13 regard, tell me about it.

09:55:03 14 MR. REISNER: Your Honor, we agree that it -- it
09:55:07 15 largely alleviates the prejudice. We still think there's
09:55:13 16 prejudice to just disruption of the business, but -- but
09:55:16 17 certainly that goes a long way to protecting Charter
09:55:18 18 against another suit.

09:55:20 19 THE COURT: All right. Then, thank you,
09:55:23 20 Mr. Reisner.

09:55:24 21 I'll grant the Plaintiff's motion with the
09:55:28 22 condition just mentioned, that if these same patents are
09:55:32 23 reurged against Charter in other proceedings, that Entropic
09:55:39 24 will be ordered to pay to Charter the fees and costs that
09:55:47 25 Charter can show are attributable to its defense of those

09:55:53 1 patents in this action.

09:55:57 2 MR. ZHANG: Thank you, Your Honor.

09:55:57 3 THE COURT: All right. Then I know we also have a
09:56:04 4 notice that the Plaintiff filed and that the Defendants
09:56:09 5 have responded to now about issues that remained.

09:56:17 6 Maybe I can hear from the Plaintiff about what --
09:56:21 7 what issues they think still remain outstanding after
09:56:26 8 viewing the Defendant's response.

09:56:29 9 MR. SHIMOTA: Good morning, Your Honor. Thank you
09:56:32 10 for your time.

09:56:33 11 We've talked this morning with counsel. The only
09:56:38 12 issue that remains is Defendant's apparent intention to, I
09:56:43 13 guess in their view, possibly call Dr. Goldberg on issues
09:56:48 14 related to damages now which we think is improper. And if
09:56:54 15 I may explain that to you further, I will. Otherwise, we
09:56:58 16 believe that we have resolved all the issues that were --
09:57:03 17 remained to be discussed today, with the caveat that -- I
09:57:05 18 believe we had at the last pretrial conference raised the
09:57:08 19 possibility of extending the trial time in this matter. So
09:57:11 20 we just would like to know if that were the case, and if
09:57:13 21 it's not, just so we can prepare for trial, but --

09:57:16 22 THE COURT: I do intend to reach that. And
09:57:19 23 frankly, some of these issues affect the time that the
09:57:24 24 Court thinks is appropriate.

09:57:26 25 So -- but that is on the agenda, as well.

09:57:30 1 MR. SHIMOTA: Thank you, Your Honor.

09:57:32 2 THE COURT: Talk to me about Dr. Goldberg.

09:57:34 3 MR. SHIMOTA: Yes, sir.

09:57:36 4 So Dr. Goldberg in this case was disclosed as
09:57:41 5 Defendant's invalidity expert. He provided opinions on
09:57:46 6 anticipation, obviousness, written description, enablement,
09:57:51 7 and Section 101 subject matter eligibility.

09:57:54 8 You granted summary judgment on some of those
09:57:57 9 issues, 101, for example. You also struck some of
09:58:00 10 Dr. Goldberg's opinions. And on Monday of this week,
09:58:03 11 pursuant to the DCO, Defendants notified us that they were
09:58:09 12 no longer going to pursue invalidity -- invalidity defenses
09:58:12 13 at trial. We thought, great.

09:58:15 14 On Tuesday morning, just as a housekeeping matter,
09:58:18 15 we sent them an email, amongst other things, asking them to
09:58:22 16 confirm that Dr. Goldberg would no longer be coming to
09:58:24 17 testify at trial so that we could prepare.

09:58:28 18 Their response was surprising. Their response was
09:58:31 19 that they now may, quote, unquote, may call Dr. Goldberg to
09:58:37 20 testify on patent damages. This was surprising. There's
09:58:43 21 nothing in Dr. Goldberg's report at all concerning patent
09:58:48 22 damages.

09:58:48 23 We had a meet and confer with them on Wednesday in
09:58:51 24 which we asked them to identify what paragraphs of
09:58:54 25 Dr. Goldberg's report pertain to patent damages. They said

09:59:00 1 that the Georgia-Pacific factors do identify the old
09:59:05 2 modes -- they talk about -- you know, a damages expert can
09:59:08 3 look at old modes that came before the invention, and
09:59:12 4 people can consider the incremental advance of the
09:59:15 5 invention over old modes.

09:59:17 6 But we -- again, we asked them: Where does this
09:59:19 7 appear in Dr. Goldberg's report? They didn't tell us. We
09:59:23 8 asked them again yesterday in an email: Please tell us
09:59:26 9 what paragraphs of Dr. Goldberg's report relate to patent
09:59:32 10 damages. It's not there.

09:59:33 11 I was looking at Dr. Goldberg's expert opinion,
09:59:37 12 and I deposed him in this matter, and there's a section --
09:59:40 13 the legal section. And he was candid, like all experts,
09:59:43 14 and said, the lawyers helped me write this. There's
09:59:46 15 nothing at all about damages there, zero, nothing. There's
09:59:50 16 a legal description of the -- of anticipation, obviousness,
09:59:55 17 written description, enablement, level of skill in the art.
09:59:59 18 Indeed, they say that he's going to testify about the,
10:00:02 19 quote, unquote, state of the art.

10:00:03 20 Literally, literally, the only place in this
10:00:07 21 report that there's a -- the use of the words "state of the
10:00:11 22 art" is in the section on enablement where one of the
10:00:13 23 factors for enablement is the state of the art, and
10:00:16 24 Dr. Goldberg said the lawyers wrote this. There's nothing
10:00:19 25 for him to testify about.

10:00:20 1 I took his deposition, Your Honor. If we had been
10:00:23 2 told at the time -- if we received fair disclosure, fair
10:00:26 3 notice under Rule 26 that he was going to be a damages
10:00:30 4 expert, I would have changed my deposition strategy. I
10:00:33 5 would have asked him questions about that. But we didn't
10:00:36 6 receive notice of that. We're receiving notice of that
10:00:38 7 this week. This is trial by ambush.

10:00:41 8 And to underscore the point that he is not and
10:00:44 9 never was a damages expert, Mr. Bakewell -- Mr. Bakewell
10:00:46 10 testifies regularly in this court. There's nothing,
10:00:49 11 there's zero in Mr. Bakewell's expert report on patent
10:00:53 12 damages concerning discussions with Dr. Goldberg or his
10:00:55 13 reliance upon Dr. Goldberg's report, nothing.

10:00:59 14 And so -- and just even more so in -- in the
10:01:03 15 notice, the response to our notice they filed this morning,
10:01:06 16 they state that they're not -- Dr. Goldberg is not going to
10:01:09 17 testify about any of the prior art that's in his expert
10:01:12 18 report. Well, then the question is what, then, is he going
10:01:14 19 to talk about? Is he some kind of a fact witness who's
10:01:18 20 going to testify about what came in those time periods?

10:01:20 21 He didn't have any of that in his report, and,
10:01:23 22 indeed, I brought his deposition here. I asked him
10:01:25 23 questions at the start of his deposition about his
10:01:30 24 experience --

10:01:30 25 THE COURT: Mr. Shimota, why don't we do it this

10:01:33 1 way? Rather than you rebutting everything they might
10:01:37 2 say --

10:01:38 3 MR. SHIMOTA: Okay.

10:01:38 4 THE COURT: -- let me hear what they do say, and
10:01:41 5 then I'll give you a chance to respond.

10:01:44 6 MR. SHIMOTA: Fair enough. Sometimes I get wound
10:01:47 7 up, Your Honor. Thank you.

10:01:47 8 THE COURT: Not a problem, Mr. Shimota.

10:01:48 9 MR. SHIMOTA: Thank you.

10:01:48 10 MR. DACUS: I'll try to lower the emotions in the
10:01:52 11 room, Your Honor.

10:01:52 12 I do think this is -- this is simple, Your Honor.
10:01:54 13 Your Honor has had the privilege -- I'll put that in
10:01:58 14 quotes -- of reading the deeply interesting motions to
10:02:01 15 strike on the -- on the damages side of the case, and you
10:02:04 16 know that apportionment is a very big issue for all three
10:02:08 17 patents in the case and, specifically, our claim that the
10:02:13 18 Plaintiff's expert has not apportioned.

10:02:16 19 All we propose that Dr. Goldberg do is talk about
10:02:20 20 the existing prior art. He will not -- he will not be
10:02:26 21 rendering any opinions as to invalidity. He will just be
10:02:29 22 talking about the prior art that is in his report, and that
10:02:32 23 goes to the apportionment issue, Your Honor.

10:02:36 24 THE COURT: So tell me what parts of his report
10:02:39 25 you would intend to have him testify about.

10:02:44 1 MR. DACUS: So it's -- it's difficult to point the
10:02:47 2 Court to the -- to the paragraphs, and I cannot do that
10:02:49 3 right now, but I'd be happy to do that. But I will say
10:02:52 4 generally, of course, because he has an invalidity report,
10:02:55 5 his report is replete. You know, dozens of paragraphs
10:02:59 6 related to the prior art that existed. And that goes
10:03:03 7 directly to the apportionment issue and our claim that the
10:03:07 8 Plaintiff has completely failed to apportion here. This
10:03:10 9 is -- this is not a -- you --

10:03:14 10 THE COURT: Who would opine, based on that prior
10:03:17 11 art, that the asserted patents are a small increment over
10:03:24 12 the prior art?

10:03:25 13 MR. DACUS: In general, Mr. Bakewell does it. He
10:03:30 14 does not do it relying on Dr. Goldberg. I -- I agree with
10:03:34 15 counsel on that.

10:03:35 16 But throughout Mr. Bakewell's report, as the Court
10:03:39 17 knows because you've seen these motions, our contention is
10:03:43 18 that they completely failed to apportion for any of these
10:03:47 19 three patents.

10:03:50 20 THE COURT: So I -- I understand that, you know,
10:03:56 21 Dr. Bakewell can say whatever he will that's in his report.
10:03:59 22 I'm just at this point focused on Dr. Goldberg and what
10:04:08 23 parts of his report you would contend he can testify to the
10:04:15 24 jury about since you have withdrawn the invalidity defense.

10:04:21 25 MR. DACUS: It would be the paragraphs in general,

10:04:25 1 Your Honor, and I'm not -- I'm not citing you to the
10:04:26 2 specific ones, and I can if the Court requests it. We're
10:04:29 3 happy to do that.

10:04:30 4 But in general, it is the paragraphs where he
10:04:33 5 talks about the art that existed, the prior art, without
10:04:41 6 rendering an opinion on validity because we -- we believe
10:04:44 7 that prior art issue is directly relevant to the
10:04:47 8 apportionment issue.

10:04:52 9 THE COURT: Well, I tell you what, I -- I have
10:04:56 10 come out here, I believe, without exhibits, which I want to
10:05:04 11 get to next, so I'm going to take a break at the moment to
10:05:10 12 go do that.

10:05:11 13 I'll also pull up what we have of Dr. Goldberg's
10:05:17 14 report, and I'd ask you to take a look, during the break,
10:05:21 15 at some representative examples of the way you would intend
10:05:28 16 to present this through Dr. Goldberg so that I can have a
10:05:32 17 little better understanding and so that Mr. Shimota can
10:05:36 18 have a target.

10:05:37 19 MR. DACUS: Understood, Your Honor. And I will
10:05:39 20 say with respect to the -- what the Court anticipates
10:05:42 21 doing, you said something about exhibits and maybe depo
10:05:46 22 designations. I'm not -- I think we have resolved all of
10:05:47 23 those issues.

10:05:48 24 THE COURT: All right. There were -- the last
10:05:53 25 three buckets, I think, that were on the list from last

10:05:56 1 time we did not reach because they were assumed to rise and
10:06:00 2 fall with certain motions. And I just need to get back to
10:06:04 3 those and confirm that they have risen or fallen.

10:06:08 4 MR. DACUS: Understood, Your Honor. My under --
10:06:10 5 we'll talk over the break.

10:06:10 6 THE COURT: Okay.

10:06:11 7 MR. DACUS: My understanding is we've resolved it
10:06:13 8 all, but --

10:06:15 9 THE COURT: All right. Well, that -- that would
10:06:16 10 be welcomed news.

10:06:16 11 MR. DACUS: Yes, Your Honor.

10:06:17 12 THE COURT: And we'll check on you in a minute and
10:06:19 13 give you what -- the time you need and then come back and
10:06:23 14 deal with Dr. Goldberg.

10:06:23 15 MR. DACUS: Thank you, Your Honor.

10:06:24 16 THE COURT: All right. Thank you.

10:06:25 17 COURT SECURITY OFFICER: All rise.

10:06:25 18 (Recess.)

10:19:04 19 COURT SECURITY OFFICER: All rise.

10:19:06 20 THE COURT: Good morning again. Please be seated.
10:19:33 21 Except for you, Mr. Dacus.

10:19:36 22 MR. DACUS: All right. At least you said it with
10:19:43 23 a smile.

10:19:46 24 So, Your Honor, where -- I think -- is it okay to
10:19:48 25 proceed, Your Honor?

10:19:49 1 THE COURT: Yes.

10:19:49 2 MR. DACUS: Thank you.

10:19:51 3 So consistent with what we were saying, Your
10:19:55 4 Honor, this is a situation where Dr. Goldberg would simply
10:20:00 5 be testifying to exactly what is in his report, not outside
10:20:03 6 of his report, and reciting to the jury what was in the
10:20:09 7 prior art.

10:20:12 8 As an example, we've referred counsel to Paragraph
10:20:15 9 247 of his report. Also Paragraph 270 does the same thing.
10:20:21 10 And there's a multitude --

10:20:23 11 THE COURT: Let me get to one of those paragraphs.

10:20:25 12 MR. DACUS: Yes, sir. 247, Your Honor.

10:20:36 13 THE COURT: All right. I'm at that paragraph.

10:20:38 14 MR. DACUS: So in 247, the reference that's cited
10:20:43 15 is this Caporizzo reference, and Dr. Goldberg has just a
10:20:48 16 recitation of what Caporizzo disclosed. In other words,
10:20:53 17 that's what's old, that's what's not incremental and new in
10:20:57 18 this particular invention.

10:20:59 19 THE COURT: So that's -- it's the -- in other
10:21:02 20 words, that could be the issue. Is the "in other words"
10:21:06 21 that you're referring to in the Goldberg report?

10:21:10 22 MR. DACUS: The fact that -- when I said, "in
10:21:17 23 other words," Your Honor, I'm trying to understand what
10:21:19 24 you're asking me.

10:21:20 25 THE COURT: Oh, well, you said: In other words,

10:21:22 1 this is what is not -- this is what was in advance of the
10:21:32 2 current patent, and, therefore, is not, you know, novel.

10:21:43 3 And I'm just trying to figure out -- are you
10:21:46 4 really intending that Dr. Goldberg would simply say
10:21:53 5 Caporizzo teaches as follows, and then that would be the
10:21:56 6 end of that?

10:21:57 7 MR. DACUS: That -- that's correct, Your Honor.
10:21:58 8 And not -- not limited to this paragraph, but as in the
10:22:01 9 general format, that's correct. And I'll -- I'll put a
10:22:04 10 little finer point on this. I mean, part of the fight
10:22:07 11 here, and Your Honor probably saw this from the briefing,
10:22:10 12 is not only are these incremental add-on inventions to what
10:22:18 13 already existed, what the Plaintiff's expert says, their
10:22:23 14 technical expert, is that these patents are fundamental to
10:22:29 15 the benefits that we receive. And they have done, in some
10:22:36 16 instances, absolutely no apportionment for what did exist.

10:22:39 17 So you have the Plaintiff's technical expert on
10:22:42 18 the one hand saying I didn't apportion at all, nor should
10:22:46 19 you apportion at all because all of the benefit is derived
10:22:49 20 from this particular patent.

10:22:51 21 What we want to say and have Dr. Goldberg
10:22:55 22 contribute to that in part is to say: A large portion of
10:22:58 23 this patent already existed in the prior art. And
10:23:03 24 Dr. Goldberg would simply recite what did exist without any
10:23:07 25 further conclusion.

10:23:08 1 THE COURT: Who is going to provide the
10:23:11 2 conclusion?

10:23:11 3 MR. DACUS: I don't -- I don't think that we
10:23:14 4 necessarily have someone to do -- to do that, nor do I
10:23:19 5 think it's necessary that we provide that conclusion.

10:23:22 6 I will say Dr. -- I mean, Mr. Bakewell will opine,
10:23:26 7 as he has, that the Plaintiff did no apportionment. And
10:23:37 8 this all goes to that apportionment issue.

10:23:41 9 As the Court probably saw and remembers from the
10:23:43 10 briefing, Mr. Bakewell does not go through and do some sort
10:23:46 11 of detailed apportionment analysis where he says: Well,
10:23:51 12 this -- this is new and this is old and this is how much I
10:23:54 13 value at. It's simply a -- the law requires apportionment,
10:23:59 14 and the Plaintiff completely failed to do it. And this is
10:24:03 15 evidence in support of that.

10:24:16 16 We would not be going outside of Dr. Goldberg's
10:24:19 17 report.

10:24:19 18 THE COURT: And that means also that the question
10:24:23 19 to Dr. Goldberg wouldn't be something along the lines of:
10:24:30 20 Dr. Goldberg, you analyzed the prior art. Can you tell us
10:24:36 21 what -- what prior art references reveal some of what is
10:24:49 22 claimed in the current patent? And then have him say this.

10:24:55 23 MR. DACUS: That's correct, Your Honor.

10:24:56 24 THE COURT: You would not?

10:24:57 25 MR. DACUS: No, we -- I think we would do that. I

10:25:01 1 mean --

10:25:01 2 THE COURT: Well, aren't you then supplying
10:25:03 3 through him an opinion that is not in his report?

10:25:06 4 MR. DACUS: I don't think so, Your Honor.

10:25:08 5 THE COURT: Does his report say that Caporizzo
10:25:18 6 teaches what it teaches here, and that is also part of what
10:25:21 7 is claimed in the patent?

10:25:24 8 MR. DACUS: He does, Your Honor. Absolutely he
10:25:26 9 does.

10:25:26 10 THE COURT: Where does he do that? That's what I
10:25:30 11 guess I need to hear.

10:25:31 12 MR. DACUS: Understood, Your Honor. I may have to
10:25:33 13 get help.

10:25:35 14 He does do that because, as the Court can likely
10:25:38 15 appreciate -- I mean, this is an invalidity report. So if
10:25:40 16 you just go to Paragraph 250, for example -- and I'm
10:25:48 17 confident there are numerous examples where he says the
10:25:52 18 particular piece of prior art discloses a limitation that
10:25:56 19 is disclosed in the patents-in-suit.

10:26:11 20 THE COURT: Well, if what you're saying is that
10:26:13 21 Dr. Goldberg is not going to say anything that's not within
10:26:16 22 the four corners of this report --

10:26:19 23 MR. DACUS: That's absolutely true.

10:26:21 24 THE COURT: -- you're just not going to be arguing
10:26:24 25 that that invalidates the patent?

10:26:25 1 MR. DACUS: That is likewise absolutely true, Your
10:26:28 2 Honor, and we're happy to make that clear.

10:26:30 3 THE COURT: Okay. Then let me hear back from
10:26:34 4 Plaintiff.

10:26:35 5 MR. SHIMOTA: Your Honor, I think you've hit the
10:26:43 6 nail on the head here. I mean, this is -- Mr. Dacus was
10:26:46 7 correct, this is an invalidity report. That's what it's
10:26:49 8 titled. And so, obviously, they do -- Dr. Goldberg
10:26:53 9 purported to do what is in an invalidity report, which is
10:26:58 10 go through it element-by-element, but they're not now
10:27:01 11 putting on an invalidity case.

10:27:04 12 And so, yes, they are going to ask him to reach
10:27:06 13 the ultimate conclusion, which is different. The
10:27:08 14 incremental advance over what was old and what's new is
10:27:12 15 completely different from what is obvious. And so if he
10:27:15 16 was going to offer an opinion about what was old and how
10:27:19 17 valuable or not valuable the advance over the art was, he
10:27:23 18 should have told us that. That should have been --
10:27:25 19 Dr. Goldberg should have disclosed that in his report, and
10:27:27 20 I would have deposed him on it.

10:27:29 21 And if they were going to rely upon that,
10:27:31 22 Mr. Bakewell should have presented that in his report. He
10:27:33 23 did not. We, of course, disagree that Mr. Dell didn't
10:27:39 24 apportion, but Mr. Bakewell had a full and fair opportunity
10:27:42 25 to respond and rely upon Dr. Goldberg. They didn't do it.

10:27:46 1 We didn't have a chance to look at this.

10:27:48 2 I want to put up on the ELMO something that we
10:27:51 3 prepared in advance. Let's see here.

10:27:59 4 THE COURT: Just rotate it one more time. There
10:28:02 5 you go.

10:28:02 6 MR. SHIMOTA: There we go. Yeah. So -- any
10:28:05 7 better there?

10:28:06 8 So these are the introductions of his first expert
10:28:09 9 report and his second expert report in which Dr. Goldberg
10:28:13 10 very plainly states that his report is solely related to
10:28:18 11 the invalidity of the claims.

10:28:21 12 And just to underscore the point, I took his
10:28:23 13 deposition, and I asked him: What is your report about?

10:28:28 14 And he told me: Let me be clear, Mr. Shimota, my
10:28:32 15 report is about invalidity.

10:28:34 16 If he'd told me at the time it was about damages,
10:28:37 17 I would have asked him questions about that. We didn't.
10:28:40 18 We learned this week that suddenly Dr. Goldberg is a
10:28:43 19 damages expert. That's unfair surprise.

10:28:45 20 And let me just add one more point, Your Honor.
10:28:50 21 Today is the first day where they started to identify
10:28:53 22 paragraphs that Dr. Goldberg would rely upon. They
10:28:55 23 identified Paragraph 270 of the report, which pertains to
10:29:00 24 Claims 1 and 2 -- or Claim 1 of the '008 patent. Guess
10:29:04 25 what, you granted summary judgment on that. They lost on

10:29:07 1 invalidity for that patent.

10:29:08 2 They're going to try to smuggle in their failed
10:29:13 3 invalidity argument under the auspices of damages when you
10:29:16 4 granted summary judgment on that. It can't possibly be.
10:29:19 5 You need to stop this.

10:29:20 6 THE COURT: Well, as long as Dr. Goldberg's
10:29:24 7 testimony is held to the four corners of his report, how
10:29:30 8 are you worse off that they are now saying they're not
10:29:35 9 going to be seeking a finding of invalidity?

10:29:39 10 MR. SHIMOTA: Well, it's unfair surprise. The
10:29:43 11 whole point of Rule 26 is that you get disclosure of the
10:29:47 12 opinions that are going to be offered, and you're afforded
10:29:50 13 a full and fair opportunity to cross-examine an expert on
10:29:53 14 that.

10:29:53 15 If I -- if I -- as I said, if I had known -- if
10:29:57 16 his report had stated that I'm going to offer damages
10:30:00 17 opinions, we would have asked him questions about that.
10:30:02 18 The trial is not the time to develop cross-examination.
10:30:06 19 The federal rules are clear --

10:30:08 20 THE COURT: These are not damages opinions that
10:30:11 21 he's offering. These are opinions that may in some way
10:30:18 22 relate to the damages opinion that someone else is going to
10:30:22 23 offer.

10:30:23 24 But how does the use that the Defendant wants to
10:30:28 25 put to the opinion change it?

10:30:31 1 MR. SHIMOTA: Well, what I would say first is
10:30:33 2 invalidity is not part of the case. So now the evidence is
10:30:37 3 both irrelevant and highly confusing to the jury. It
10:30:41 4 just -- it just comes out of nowhere. So --

10:30:44 5 THE COURT: How is it confusing? They don't know
10:30:46 6 that there ever was an invalidity claim, and they're going
10:30:50 7 to hear that there is not one. So I don't see how that
10:30:58 8 would confuse the jury.

10:31:00 9 MR. SHIMOTA: Well, because there's no -- there's
10:31:02 10 no damages expert in this case who's going to testify.
10:31:05 11 And, indeed, Mr. Dacus conceded that, that no one is going
10:31:08 12 to testify, is going to make the critical linkage between
10:31:11 13 the prior art that -- that Mr. Goldberg apparently is going
10:31:14 14 to read -- Doctor, pardon me -- Dr. Goldberg apparently is
10:31:18 15 going to read in the record and damages. So he apparently
10:31:22 16 is going to come there, take a patent, read passages from a
10:31:27 17 patent, and then sit down. That will be confusing to a
10:31:29 18 jury.

10:31:30 19 And to the extent that he goes further than that,
10:31:32 20 I, again, say that we should have had the opportunity to
10:31:34 21 cross-examine him in a deposition. I didn't --

10:31:37 22 THE COURT: Does Mr. Bakewell offer the opinion
10:31:39 23 that this -- the patents make a limited contribution to the
10:31:48 24 prior art?

10:31:48 25 MR. SHIMOTA: No, he does not. All he does -- he

10:31:52 1 does not offer -- he -- in fact, Mr. Bakewell offers no
10:31:55 2 affirmative opinion on damages. He doesn't have an opinion
10:31:57 3 as to what they are. All he does is he -- is criticize
10:32:01 4 Mr. Dell. He says Mr. Dell didn't apportion enough. He
10:32:03 5 did a bad job.

10:32:05 6 He does not argue that, that there was some --
10:32:09 7 that the patents aren't as valuable as we say, and they're
10:32:11 8 only a small advance over the prior art. That's nowhere in
10:32:15 9 the record. That's not going to be presented to the jury
10:32:17 10 at this trial.

10:32:17 11 And so, again, I submit having Mr. -- Dr. Goldberg
10:32:21 12 show up to apparently -- I mean, we don't even know what
10:32:24 13 paragraphs he -- to this day, we've asked numerous times.
10:32:28 14 We have a few snippet of paragraphs. We don't know what
10:32:31 15 he's going to do, but apparently he's going to sit on the
10:32:32 16 stand and take patents and read from them. That has
10:32:36 17 nothing to do with any of the issues in the case, and
10:32:36 18 it's --

10:32:36 19 THE COURT: You don't have that --

10:32:40 20 MR. SHIMOTA: -- highly prejudicial.

10:32:41 21 THE COURT: -- you don't have that information
10:32:44 22 about any expert, do you, about what paragraphs of your
10:32:47 23 report are you going to be relying upon in your testimony?

10:32:50 24 MR. SHIMOTA: Well, but at least we have fair
10:32:52 25 notice for the other experts as to what might be in play.

10:32:54 1 I don't know what Dr. Goldberg -- what is
10:32:56 2 potentially in play for him. We haven't -- I've learned
10:32:58 3 today that it might be Paragraphs 247 and Paragraph 270.
10:33:02 4 And as I identified for you, Paragraph 270 is one upon
10:33:06 5 which you granted summary judgment of no invalidity. So on
10:33:09 6 that one, it would be prejudicial for Dr. Goldberg to show
10:33:12 7 up and say: Well, that there's -- that there's some
10:33:15 8 difference between our claims -- or that the prior art
10:33:17 9 discloses everything. So there's no real advance there
10:33:20 10 because he was wrong. You ruled against him on that.

10:33:24 11 And so they shouldn't be able to do that. And so
10:33:25 12 we don't -- we don't know. I mean, I agree with you, Your
10:33:28 13 Honor, you never know precisely what a witness is going to
10:33:31 14 testify until they take the stand in the trial, but at
10:33:33 15 least you need to have some notice. And we don't have
10:33:36 16 that. We simply don't.

10:33:38 17 THE COURT: Well, I guess -- frankly, I don't know
10:33:47 18 everything that he's going to be saying or what portions of
10:33:53 19 his report they can rely upon for the argument that they're
10:33:56 20 now making, but my primary concern about experts is that
10:34:02 21 they have fully disclosed their opinions and that they'll
10:34:06 22 be held to those opinions at trial.

10:34:09 23 And even though they no longer -- the Defendant no
10:34:16 24 longer has an invalidity defense, if there are opinions in
10:34:22 25 Dr. Goldberg's report that are relevant to the remaining

10:34:26 1 issues, I don't know a basis to exclude them.

10:34:33 2 MR. SHIMOTA: Well, under -- as I said, under
10:34:35 3 Rule -- in my view, Your Honor, respectfully, I think
10:34:40 4 Rule 37 provides that there needs to be disclosure of
10:34:42 5 opinions in advance. And these opinions -- 270, it's
10:34:45 6 talking about a -- it reads: In my opinion, a POSITA would
10:34:47 7 be highly motivated to combine Coyne with Caporizzo.
10:34:52 8 That's the language of obviousness. There's no language in
10:34:55 9 this report where there's a discussion of Caporizzo
10:34:58 10 discloses X, and the incremental advance over Caporizzo is
10:35:02 11 Y, and Y isn't particularly valuable.

10:35:04 12 If there was that, we would have been able to --
10:35:07 13 to ask questions about that and say, I think you're wrong
10:35:10 14 Dr. Goldberg. Have you considered this and this? That's
10:35:13 15 not there. That's prejudicial. And so under Rule 37, I
10:35:16 16 think you do have the authority to prevent Dr. Goldberg
10:35:18 17 from offering this testimony. I mean, his opinions are --
10:35:22 18 this is an invalidity report. He's -- he's speaking in the
10:35:25 19 language of obviousness.

10:35:26 20 The three patents that are asserted in this case
10:35:28 21 remaining, the only arguments that they -- that
10:35:31 22 Dr. Goldberg advanced were claims of obviousness. He
10:35:34 23 wasn't arguing that the prior art completely anticipated.

10:35:37 24 So his opinions are tied specifically on those
10:35:41 25 elements to -- that's the language he's using. That's what

10:35:45 1 his opinions are. And that -- that is irrelevant, and it
10:35:48 2 would be prejudicial. It has nothing to do with damages at
10:35:50 3 all. It's different.

10:35:54 4 There's similarities in between Georgia-Pacific 9
10:35:56 5 and obviousness, but they're separate legal inquiries, and
10:36:00 6 that was not addressed by Dr. Goldberg in his report, and
10:36:03 7 that's prejudicial.

10:36:03 8 THE COURT: All right.

10:36:04 9 MR. SHIMOTA: Thank you, Your Honor.

10:36:05 10 THE COURT: Thank you, Mr. Shimota.

10:36:07 11 Mr. Dacus, one more thing. You have shown me the
10:36:10 12 paragraphs where Dr. Goldberg discusses the prior art.
10:36:18 13 What I really haven't seen is an opinion that Dr. Goldberg
10:36:25 14 offers that would be relevant for the reason you've set
10:36:29 15 out, that he shows that it's only a minor advance over the
10:36:34 16 prior art.

10:36:37 17 Can you point out an opinion that you think would
10:36:41 18 still be relevant?

10:36:42 19 MR. DACUS: I may need to confer with my
10:36:47 20 co-counsel, Your Honor, but I don't think there's opinions
10:36:49 21 in there where he necessarily says that it is -- he doesn't
10:36:53 22 say that it is a minor improvement or any improvement over
10:36:57 23 the -- over the prior art, but --

10:37:00 24 THE COURT: Well -- and that's fine. I didn't
10:37:02 25 mean to cabin you to that opinion, but any opinion that you

10:37:07 1 contend is still relevant. The paragraphs you pointed to
10:37:13 2 originally are just opinions where he's quoting the prior
10:37:20 3 art.

10:37:20 4 Where does he supply an opinion that relies upon
10:37:24 5 that in a relevant fashion? And if you need to consult
10:37:30 6 with other counsel, if you need another short break, I'm
10:37:34 7 happy to give you that. But I -- I am concerned about
10:37:39 8 saying that the witness can still go forward repurposed if
10:37:47 9 there's no relevant opinion disclosed in his report.

10:37:51 10 MR. DACUS: And I think the -- the -- I'm not sure
10:37:56 11 if the Court is focusing in on the word "opinion," but
10:38:01 12 there are relevant facts in the report, Your Honor.

10:38:03 13 THE COURT: Well, the facts are only relevant if
10:38:06 14 someone can show their relevance. And what I'm afraid that
10:38:11 15 you want to do is have a lawyer be the one to show the
10:38:16 16 relevance of those facts by providing the opinion that
10:38:21 17 those facts show that it's only a minor advance. And I
10:38:26 18 think that is inherently an opinion that needs to come from
10:38:30 19 an expert.

10:38:30 20 MR. DACUS: And let me be clear. I don't think we
10:38:35 21 intend on necessarily saying that it's a minor advance.
10:38:38 22 Our purpose in putting this evidence forward is what
10:38:43 23 Your Honor saw in the briefing, and that is to say for
10:38:46 24 certain patents, particularly ones that are now at issue,
10:38:50 25 Dr. -- Mr. Dell did no apportionment at all. And the

10:38:56 1 purpose of putting forth Dr. Goldberg is to say here
10:39:01 2 factually is what was in the prior art.

10:39:06 3 When the Plaintiffs stand up and say, as they
10:39:08 4 inevitably will, that this patent is fundamental to the
10:39:13 5 benefit that Charter receives for PMA, for example, for
10:39:17 6 that feature, and we did no apportionment at all, we
10:39:20 7 attributed 100 percent to this patent, Mr. Bakewell has
10:39:25 8 opined that apportionment was required.

10:39:29 9 And this is factual testimony in an expert
10:39:33 10 report -- facts from an expert report that provide evidence
10:39:37 11 of the fact that there -- there were elements or
10:39:40 12 limitations of these patents that existed in the prior art.

10:39:54 13 THE COURT: And I guess what I am missing from
10:39:56 14 that is who is going to make the connection that this prior
10:40:01 15 art is talking about something that's within the scope of
10:40:05 16 the asserted claims?

10:40:06 17 MR. DACUS: Oh, I think Mr. -- Dr. Goldberg does
10:40:08 18 that for sure.

10:40:09 19 THE COURT: Well, and that's what I'm looking for
10:40:13 20 is where there is an opinion like that that is relevant.

10:40:18 21 MR. DACUS: Understood, Your Honor.

10:41:12 22 So, Your Honor, if you look at Paragraph 271 --
10:41:15 23 and I'll say just as an overarching comment, as the Court
10:41:22 24 might expect, I mean, this does have invalidity opinions in
10:41:26 25 it, so you can imagine by necessity the expert has in here

10:41:31 1 recitations of the prior art in tying those to the
10:41:35 2 patents-in-suit, just as an overarching matter.

10:41:37 3 But specifically with respect to 271, Claim
10:41:42 4 Limitation 1[c], Dr. Goldberg says is in the prior art
10:41:47 5 reference Coyne. And, of course, we're talking about the
10:42:01 6 '008 patent here, but it -- we have the same thing for all
10:42:04 7 of the patents. We have Dr. Goldberg saying: The claim
10:42:09 8 limitations at issue in this suit were in the prior art.

10:42:16 9 THE COURT: All right. And the '008 is still at
10:42:21 10 issue. It's still asserted, right?

10:42:23 11 MR. DACUS: Yes, Your Honor.

10:42:24 12 THE COURT: So you're saying that in Paragraph
10:42:28 13 271, there would be a basis for Dr. Goldberg to testify
10:42:32 14 that part of what is claimed in the '008 patent is already
10:42:45 15 taught in this pre-existing Coyne reference?

10:42:48 16 MR. DACUS: That's correct, Your Honor.

10:43:00 17 THE COURT: All right. Let me hear from
10:43:04 18 Mr. Shimota as to why that would not be a permissible use
10:43:07 19 of Paragraph 271.

10:43:08 20 MR. SHIMOTA: Well, Your Honor, specifically with
10:43:13 21 respect to Paragraph 271, I want to reiterate for you, we
10:43:17 22 moved for summary judgment on Claim 1 of the '008 patent
10:43:21 23 that they had not shown obviousness. You granted our
10:43:25 24 motion. You stated that -- that they -- Dr. Goldberg was
10:43:29 25 wrong. So now they're going to -- they're trying --

10:43:32 1 they're trying to have Dr. Goldberg testify about a theory
10:43:34 2 that they wouldn't have been able to present to the jury on
10:43:37 3 obviousness. He's wrong.

10:43:38 4 Moreover, you asked Dr. -- Mr. Dacus the question:
10:43:44 5 Where in the report is there any discussion of an -- small
10:43:49 6 advance, incremental advance, et cetera? There is none.

10:43:52 7 The language here is precisely in the context of
10:43:56 8 obviousness. And so, again, this isn't a fair use of this.
10:44:00 9 If they had said -- if there was a sentence in here that
10:44:03 10 said, moreover, this is an incremental advance and it's not
10:44:06 11 particularly valuable -- you know, moreover, if I'm wrong
10:44:08 12 on obviousness, the differences between the claims and the
10:44:11 13 prior art were so small that it's not valuable, I could
10:44:15 14 asked him questions about that, but he didn't answer those
10:44:19 15 questions.

10:44:19 16 And you see, it's -- the bigger problem is that
10:44:21 17 this is -- right now they're literally on the fly finding
10:44:24 18 paragraphs that he's going to be testifying to. And it
10:44:26 19 shows, right? They're pointing you to paragraphs that you
10:44:31 20 granted summary judgment on.

10:44:32 21 THE COURT: You know --

10:44:33 22 MR. SHIMOTA: Mr. Bakewell -- I'm sorry. I didn't
10:44:36 23 mean to cut you off, Your Honor.

10:44:36 24 THE COURT: The summary judgment on obviousness
10:44:39 25 related to entire claims, not just limitations like this

10:44:40 1 paragraph.

10:44:41 2 MR. SHIMOTA: Uh-huh.

10:44:45 3 THE COURT: So --

10:44:47 4 MR. SHIMOTA: Yeah, but -- I'm sorry. I cut you
10:44:47 5 off. Were you finished?

10:44:47 6 THE COURT: No. Go ahead.

10:44:48 7 MR. SHIMOTA: That's the point. If they just go
10:44:50 8 to Paragraph 271 in isolation and say this isn't there,
10:44:53 9 you're correct. They're then going to ask the question of,
10:44:57 10 like, okay, well, how much of a difference is there? And
10:45:01 11 if they don't ask that question, you're right. Is someone
10:45:06 12 going to argue about this, because if someone is not even
10:45:07 13 going to argue this evidence, then how on earth is it
10:45:09 14 relevant?

10:45:09 15 And you're correct, if an attorney argues that the
10:45:12 16 advance of the art over the -- or the advance of the
10:45:15 17 invention over the art is, quote, unquote, incremental or
10:45:18 18 not valuable, that's for an expert. That was for
10:45:21 19 Mr. Bakewell to do, and he didn't do it.

10:45:24 20 I want to be clear, Mr. Bakewell doesn't offer an
10:45:26 21 opinion that the advance over this art or Caporizzo or
10:45:32 22 Coyne or whatever was so small that it wasn't valuable.
10:45:35 23 All he does is he says: Mr. Dell is wrong. Mr. Dell did a
10:45:39 24 bad job.

10:45:40 25 It's fine for him to say that, but they can't

10:45:43 1 bring in this new theory the last week before trial. It's
10:45:45 2 just not fair. It's trial by surprise. I mean, there's
10:45:48 3 not even time to do -- I mean, to depose Dr. Goldberg on
10:45:51 4 his repurposed opinion that isn't even in this report. So
10:45:55 5 that's why you simply shouldn't do it.

10:45:58 6 And I -- again, for them to be able to try and put
10:46:00 7 on the theory that you granted summary judgment on for
10:46:03 8 obviousness under the guise of damages or some
10:46:08 9 Georgia-Pacific factor is not -- is not fair. I mean, I
10:46:12 10 would just, again, submit to Your Honor they informed
10:46:15 11 Dr. Goldberg on the law. There's nothing about the
10:46:18 12 Georgia-Pacific factors in his report, nothing, zero. He
10:46:23 13 knew nothing about it. There's no discussion of it.

10:46:26 14 They decided not to pursue an invalidity defense
10:46:29 15 in this case, and then they made the strategic choice to
10:46:32 16 try to repurpose it -- your language is right -- as a
10:46:32 17 damages opinion, it's too late. It's unfair. It shouldn't
10:46:35 18 be allowed.

10:46:36 19 THE COURT: All right.

10:46:38 20 MR. SHIMOTA: Thank you, Your Honor.

10:46:38 21 THE COURT: Thank you, Mr. Shimota.

10:46:39 22 I am going to take a little bit of time and review
10:46:48 23 Dr. Goldberg's report further, and I'll issue something in
10:46:52 24 writing about whether or not the Court believes that the
10:47:00 25 proposed use of Dr. Goldberg is a fair use in light of the

10:47:05 1 disclosure of his opinions.

10:47:08 2 And if you want to say any last words on that,
10:47:11 3 Mr. Dacus, I'll be happy to give you that opportunity.

10:47:14 4 MR. DACUS: Just one thing, Your Honor. I mean,
10:47:17 5 we've got a lot of discussion about opinions and what
10:47:19 6 lawyers can say. Lawyers can, of course, apply the facts
10:47:24 7 through the instructions that the Court gives. The Court
10:47:26 8 is no doubt in this case going to give an instruction that
10:47:30 9 apportionment is required. I'm confident -- I'm confident
10:47:33 10 of very little in this case, but I'm confident of that.

10:47:36 11 And this goes directly to that issue upon which --
10:47:42 12 as you know, Mr. Bakewell has said there is no
10:47:44 13 apportionment by the Plaintiff. So the argument here,
10:47:48 14 applying the facts to the law, say these things existed in
10:47:52 15 the prior art previously. Mr. Dell, the Plaintiff's
10:47:55 16 expert, did no apportionment with respect to them. And the
10:47:57 17 Court's instructions say that he should have. I don't
10:48:00 18 think it's any more complicated than that.

10:48:03 19 THE COURT: And another issue that I'm going to
10:48:07 20 look at this report about is whether there was fair notice
10:48:12 21 that Dr. Goldberg would be testifying about anything other
10:48:17 22 than invalidity.

10:48:19 23 MR. DACUS: He's testifying -- I mean, his report
10:48:26 24 is on matters that relate to what was in the prior art,
10:48:36 25 what the state of the art was. As Mr. Shimota said, he

10:48:41 1 read a paragraph that said what the state of the art is.

10:48:45 2 In my experience, Your Honor, it is not
10:48:46 3 uncommon -- in fact, it occurs in almost every case -- that
10:48:49 4 you take what the invalidity expert said and you apply that
10:48:53 5 with respect to the apportionment issue. And I don't think
10:48:57 6 it's any different here.

10:48:59 7 THE COURT: Well, I guess in those cases, there is
10:49:04 8 an invalidity defense, and the expert is testifying about
10:49:06 9 that defense.

10:49:07 10 And I agree that that testimony can be relied upon
10:49:11 11 in different aspects of the case. But what I'm
10:49:16 12 understanding is there will not be an invalidity defense in
10:49:20 13 this case.

10:49:21 14 MR. DACUS: That's -- that's absolutely true, Your
10:49:23 15 Honor.

10:49:23 16 THE COURT: All right. Well, I -- I think I
10:49:26 17 understand the issue, and I'll try and -- and come to a
10:49:31 18 definitive --

10:49:33 19 MR. DACUS: Thank you.

10:49:34 20 THE COURT: -- resolution of it.

10:49:41 21 MR. DACUS: Thank you, Your Honor.

10:49:42 22 THE COURT: Thank you.

10:49:43 23 As I understand it, that is the only issue that
10:49:50 24 remained from the notice that the Plaintiff filed, I guess,
10:49:55 25 the night before last.

10:49:57 1 Is that right, Mr. Shimota?

10:49:58 2 MR. SHIMOTA: That is correct, Your Honor. Thank
10:50:00 3 you.

10:50:00 4 THE COURT: Tell me about the agreements then that
10:50:07 5 have resolved the exhibit issues that were left unresolved
10:50:11 6 after the last pretrial. And those are specifically, I
10:50:20 7 guess -- I'm looking at the email with the bucket list, and
10:50:26 8 Bucket 3 and then 6, 7, and 8 were --

10:50:33 9 MR. SHIMOTA: My understanding is Buckets 3, 7,
10:50:36 10 and 8, that we've agreed that those will not be admitted,
10:50:39 11 that's correct.

10:50:40 12 THE COURT: All right. Since they're Defendant's
10:50:42 13 exhibits, I guess I need to hear that from them.

10:50:45 14 MR. SHIMOTA: Yes, sorry.

10:50:47 15 THE COURT: All right. Thank you.

10:50:47 16 MR. DACUS: That's the first thing Mr. Shimota has
10:50:49 17 said today that's accurate, Your Honor.

10:50:57 18 THE COURT: I would say --

10:50:57 19 MR. SHIMOTA: Hoping once a day, twice a day, I
10:50:58 20 believe so. There you go.

10:50:58 21 THE COURT: -- it's faint praise perhaps?

10:51:03 22 So do both sides then have a list of their
10:51:11 23 pre-admitted exhibits that we can get filed today that has
10:51:17 24 been agreed to by the other side?

10:51:18 25 MR. SHIMOTA: Yeah, we'll get that to you this

10:51:21 1 afternoon.

10:51:22 2 THE COURT: All right.

10:51:22 3 MR. DACUS: Yes, Your Honor.

10:51:24 4 THE COURT: All right. What about the email that
10:51:25 5 came in yesterday evening about deposition designations?

10:51:32 6 Have those been resolved, too?

10:51:34 7 MR. SHIMOTA: Yes, Your Honor, that has been
10:51:35 8 resolved.

10:51:36 9 THE COURT: All right. And so those depositions
10:51:41 10 may be used on Monday? Is that the understanding?

10:51:46 11 MR. SHIMOTA: The designations. The issue was
10:51:47 12 that we had an issue over the counter-designations for one
10:51:51 13 witness, Mr. Boglioli. We're now no longer going to play
10:51:54 14 deposition testimony from Mr. Boglioli, so the
10:51:58 15 counter-designation issue is moot.

10:51:59 16 THE COURT: All right. So the -- perhaps the only
10:52:06 17 issue remaining is the trial time.

10:52:07 18 MR. SHIMOTA: That's correct, Your Honor, I
10:52:10 19 believe.

10:52:10 20 THE COURT: The case has been narrowed somewhat.
10:52:13 21 Certainly it went from six patents to three patents, and
10:52:18 22 some of the additional experts have been resolved.

10:52:22 23 What is the Plaintiff's position now on the trial
10:52:29 24 time that the Plaintiff needs?

10:52:31 25 MR. SHIMOTA: Your Honor, still -- while the case

10:52:34 1 has been narrowed, there are -- remain three patents, and I
10:52:34 2 believe the issues are fairly complex. So I believe that
10:52:38 3 an enlargement of two hours would still be our preference.
10:52:41 4 Obviously, we'll work with whatever time we are given, but
10:52:43 5 that remains our preference.

10:52:45 6 THE COURT: So that would be 14 hours is what
10:52:47 7 you're telling me?

10:52:47 8 MR. SHIMOTA: That's correct. Yes, Your Honor.

10:52:49 9 THE COURT: All right. Thank you, Mr. Shimota.

10:52:50 10 MR. SHIMOTA: Thank you, Your Honor.

10:52:51 11 THE COURT: Mr. Dacus, what about your side?

10:52:53 12 MR. DACUS: We think that's likely accurate, Your
10:52:56 13 Honor, 14 hours. We don't request any more than 14 hours.

10:53:00 14 THE COURT: All right. Then 14 hours will be the
10:53:03 15 order as far as time for presentation of the evidence.

10:53:08 16 And I will dig into Dr. Goldberg's report and try
10:53:17 17 to get something out promptly on that.

10:53:21 18 I understand that the juror notebooks have been
10:53:24 19 delivered to chambers. Are there any issues regarding
10:53:29 20 that?

10:53:30 21 MR. LITTMANN: Sorry, I stood up for a different
10:53:33 22 reason, Your Honor, but I don't believe there are any
10:53:35 23 issues on that.

10:53:36 24 MR. DACUS: There are no issues, Your Honor.

10:53:37 25 THE COURT: All right. Then for what reason are

10:53:41 1 you standing up?

10:53:43 2 MR. LITTMANN: Just -- just to -- I believe we
10:53:45 3 have agreement with Defendant here that the testimony of --
10:53:50 4 that there will be no testimony from either Mr. Taylor or
10:53:52 5 Mr. Cary. Those were two other issues that were there that
10:53:57 6 were outstanding, and so I just -- as we were talking about
10:53:58 7 the hours and everything else, I wanted to make sure the
10:54:01 8 Court had full information on that, as well.

10:54:03 9 THE COURT: And I think that's in their written
10:54:05 10 response to your notice --

10:54:06 11 MR. LITTMANN: Correct.

10:54:06 12 THE COURT: -- right?

10:54:08 13 MR. LITTMANN: Thank you.

10:54:08 14 MR. DACUS: I guess the only asterisk or caveat on
10:54:12 15 that, Your Honor, is we have objected to some of the
10:54:14 16 rulings from Your Honor. So if the Court were to --

10:54:18 17 THE COURT: And I understand that.

10:54:19 18 MR. DACUS: -- do something with respect to
10:54:21 19 licensing, for example, we might call those folks, but
10:54:24 20 counsel is correct, as of now, we are not calling those
10:54:27 21 folks.

10:54:27 22 THE COURT: I do understand that, that certainly
10:54:31 23 those issues are ultimately pending before Judge Gilstrap.

10:54:36 24 All right. Well, I don't think there's anything
10:54:42 25 else. I'll let y'all get back to preparing for Monday.

10:54:45 1 MR. DACUS: Thank you, Your Honor.
10:54:47 2 MR. REISNER: Thank you, Your Honor.
10:54:48 3 MR. SHIMOTA: Thank you, Your Honor.
10:54:50 4 COURT SECURITY OFFICER: All rise.
10:54:53 5 (Hearing concluded 10:54 a.m.)

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CERTIFICATION

I HEREBY CERTIFY that the foregoing is a true and correct transcript from the stenographic notes of the proceedings in the above-entitled matter to the best of my ability.

/S/ Shelly Holmes
SHELLY HOLMES, CSR, TCRR
CERTIFIED SHORTHAND REPORTER
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